

Serial No.: 09/780,222
Amendment Dated July 21, 2003
Reply to Office Action of April 21, 2004

REMARKS

Claims 3, 4, 6, 8-14 and 24-38 are pending. Claims 3, 4, 6, 8-14 and 24-38 have been rejected.

Objection to Drawings Under 37 C.F.R. 1.83(a).

Examiner objected to the drawings under 37 CFR 1.83 (a) as not showing every feature of the invention specified in the claims. In response, Figures 5, 6, 7 have been corrected to show the "bottom surface" as 21 and the "periphery" as 20'. In addition, Figure 8 has been added to show "wherein the breakaway layer is...applied in a pattern".

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the objection of the drawings under 37 CFR 1.83 (a).

Rejection of Claims 11 and 30 Under 35 U.S.C. § 112.

Examiner rejected Claims 11 and 30 under 35 U.S.C. §112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to the one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, Examiner contends that the specification or drawings do not disclose "an area adjacent the periphery of the primary film layer receives a polymer...".

Applicant respectfully points out that the specification discloses the cited matter on page 9 lines 1-4 and 18-21. The specification discloses in lines 1-4, "The breakaway coating is applied in a striped pattern or with varying thickness or varying compounds to the primary film

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layer. The pattern may be designed to coat no breakaway coating on the primary film layer in the area at the outside edge of the primary film layer. This uncoated area is approximately 3/16 inch." The specification discloses in lines 18-21, "The breakaway layer may be composed of a material having variations in thickness across the primary film layer which in turn creates variation in peel strength across the primary film layer. The peel strength may be relatively low adjacent the periphery of the primary film layer or relatively high adjacent the primary film layer." In addition, Figure 8 has been added to show the pattern.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 11 and 30 under 35 U.S.C. §112 as containing subject matter which was not described in the specification.

Rejection of Claims 3, 4, 6, 8-14, and 24-38 Under 35 U.S.C. §103.

Examiner rejected Claims 3, 4, 6, 8-14, and 24-38 Under 35 U.S.C. §103 as being unpatentable over Fischer (6, 328,340) in view of Matsuguchi et al (EP-426,863).

Applicant respectfully traverses the Examiner's rejection of those Claims under 35 U.S.C. § 103. Specifically, Applicant believes the Examiner has not established a *prima facie* case of obviousness as required under patent law and in accordance with the Manual of Patent Examining Procedure ("MPEP"). The MPEP states,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed., Cir 1991) See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

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MPEP § 706.02(j) (emphasis added). The MPEP also states,

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q.2d 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

MPEP § 2143.03 (emphasis added).

In reviewing the Examiner's 35 U.S.C. § 103 analysis in Claims 3, 4, 6, 8-14, and 24-38, it appears the Examiner has made a number of general statements regarding duplication of components disclosed prior art. However, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *In re Jones*, 958 F.2d at 347. Here, there is no such suggestion or motivation to modify Fischer such that it describes the invention of independent Claims 10, 11, 12, 24, 30, or 31. The deficiencies of references cannot be saved by appeals to common sense and basic knowledge without any evidentiary support. *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Here, the Examiner is applying an "obvious to try" rational, which is clearly improper. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *Yamanouchi Pharmaceutical Co. Ltd. V. Marsam Pharmaceuticals, Inc.*, 231 F.3d 1339 (Fed.Cir. 2000).

In addition, Fischer must provide a reasonable expectation of success for the proposed modification to render Claims 10, 11, 12, 24, 30, or 31 obvious under 35 U.S.C. §103(a). *In re Dow Chemical Co.* F.2d at 469. Here, the Examiner has failed to present evidence that the

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proposed modification would be successful. Therefore, it is submitted that 10, 11, 12, 24, 30, or 31 are patentable over Fischer, and Applicant respectfully requests that the rejection of 10, 11, 12, 24, 30, or 31 under 35 U.S.C. §103(a) be withdrawn.

It is noted that independent Claim 10 forms the basis for all dependent Claims 3, 4, 6, 8, and 9. Independent Claim 12 forms the basis for all dependent Claims 13 and 14. Independent Claim 24 forms the basis for all dependent Claims 25-29. Independent Claim 31 forms the basis for all dependent Claims 32-38. Because a dependant claim cannot be obvious if the independent claim from which it depends is not obvious, all claims depending from Claims 10, 12, 24, and 31 must also be found nonobvious because the dependent claims depend from either independent Claim 10, 11, 12, 24, 30, or 31, which are patentable over Fischer for the reasons described above.

In light of the above, Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claims 3, 4, 6, 8-14, and 24-38 as being obvious under 35 U.S.C. § 103(a).

Conclusion.

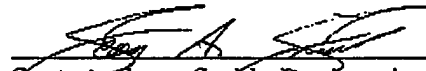
Applicant believes the above analysis and the amendments made herein overcome all of the Examiner's objections and all of the Examiner's rejections of Claims 3, 4, 6, 8-14, and 24-38, and that Claims 3, 4, 6, 8-14, and 24-38 are in condition for allowance. Therefore, it is suggested that Claims 3, 4, 6, 8-14, and 24-38 constitute allowable subject matter and should be favorably considered by the Examiner, and it is requested that a timely Notice of Allowance be issued for those Claims.

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The Commissioner is hereby authorized to charge any additional fees or credit
overpayment under 37 CFR 1.16 and 1.17, which may be required by this paper to Deposit
Account 162201.

Respectfully submitted,

Date: July 21, 2004



Scott Anthony Smith, Registration No. 46,067
POLSTER, LIEDER, WOODRUFF & LUCCHESI, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, MO 63131-3615
Telephone: (314) 238-2400
Facsimile: (314) 238-2401